

REMARKS

The undersigned attorney would like to thank the examiner charged with the responsibility of this application for the many courtesies extended during a recent telephone interview. The substance of the claims was not discussed, but rather the U.S.C. Section under which the art rejections were made. The examiner agreed that the proper section to be used is 35 U.S.C. §103(a) rather than 35 U.S.C. §102(e). The undersigned agreed to treat the art rejections as 103 rejections rather than 102 rejections.

Claims 15-19 have been rejected under 35 U.S.C. §112, second paragraph "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The reason for such rejection resides in the recitation of "conductive plates of" in claim 15. Claim 15 has been amended as suggested by the examiner, so it is believed that this 112 rejection is overcome.

Claims 1, 2, 4, 6-9, 11-14, 20, 21 and 23-26 have been rejected as being anticipated by Mosley Pub. No. US 2002/0071258A1, hereinafter Mosley, in view of Li Pub. No. US 2002/0195700A1, hereinafter Li. This rejection is not thought to be well taken. As was indicated above, in the telephone interview with the examiner he indicated that this should be treated as a rejection under 35 U.S.C. §103 (a), and the undersigned will so treat it.

While it is true that Mosley does disclose capacitors with at least two interlaced plates, with vias to connect to the circuit board, and vias parallel with each other, there is nothing in Mosley to indicate that the planes in the circuit board are both voltage planes, they are merely designated as "first and second metallization layers" (page 2, section {0022}). Moreover Li

while showing capacitors connected to a circuit board, show no internal structure of the capacitors, nor how the internal structure is related to the circuit board or I/C chip. Thus there is nothing in Li that would suggest the structural relationship of the capacitor to the other elements of the circuit structure. Claim 1 upon which claims 2, 4, 6 and 7 depend, claim 8 upon which claims 9, 11, 13 and 14 depend, and claim 20 upon which claims 21 and 23-16 depend each claim the relationship of the internal capacitor structure to both the circuit board and the I/C chip. In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir.1986). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Thus, even if the disclosures are in the same field of endeavor, there is nothing in either of the Mosley reference or the Li reference that would suggest how to combine them, especially to arrive at the applicant's claimed structure.

With respect to claims 2, 4, 6, 7, 9, 11, 13, 14, 21, and 23-26 these claims are dependent upon either claim 1, 8, or 20, and for the same reasons are believed to be allowable.

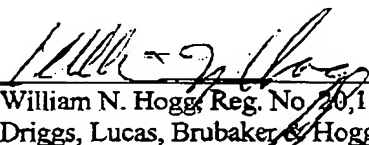
Claims 15-19 and 27-31 have been rejected under 35 U.S.C. §102 (e) as being unpatentable over Li in view of Mosley. Again, as per the telephone interview between the examiner and the undersigned, this is being treated as a rejection under 35 U.S.C. §103 (a). Again, there is nothing in Li or Mosley as to how the references can be combined or even that they can be combined. Hence, even if the disclosures are in the same field of endeavor, there is no indication that they can be combined, or that any combination would result in the applicant's device or method.

The allowability of Claims 3, 5, 10, 12, 22, and 24 is noted with appreciation. These claims have all been rewritten in independent form, or in a form that casts them as dependent upon a rewritten allowable claim; e.g. claim 3 has been rewritten as independent claim 32, claim 10 has been rewritten as independent claim 33, , claim 22 has been rewritten as independent claim 34. Each of these claims contains all of the limitations of the intermediate claims, if any. The dependency of claims 5, 12, and 24 have been correspondingly changed. Claim 16 has also been rewritten as new claim 35 and for the same reasons claims 32-34 are deemed allowable, claim 35 is also believed to be allowable. Claims 3, 10, 16, and 22 have been cancelled in favor of the newly rewritten independent claims.

In view of the above, it is believed that each of the claims now in the application is distinguishable one from the other, and over the prior art; therefore, reconsideration, and allowance of the claims is respectfully requested.

Respectfully submitted,

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